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10/528,422	09/21/2005	Bruce Leigh Kiehne	A-9488	4461
7590	12/09/2008		EXAMINER	
Hoffman Wasson & Gitler			SZPIRA, JULIE ANN	
2461 South Clark Street				
Suite 522 - Crystal Center			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,422	Applicant(s) KIEHNE, BRUCE LEIGH
	Examiner JULIE A. SZPIRA	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 June 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 March 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-166/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Receipt is acknowledged of applicant's amendment filed 6/10/2008. Claims 1-15 are pending and an action on the merits is as follows.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 13-15** are rejected under 35 U.S.C. 102(b) as being anticipated by **Herbert et al. (US 5,868,771)**.

Regarding claims 13-15, Herbert et al. discloses a safety scalpel assembly comprising a scalpel blade (300) and a guard (200), the assembly being attachable to a handle (100) of the type which has a blade carrier in the form of a finger, the scalpel blade which can be of conventional manufacture, having a slot (301) to allow the blade to be attached to the blade carrier on the handle, and the guard extending at least about the cutting edge of the blade (column 4, lines 25-30), the guard having attachment means to lock the blade to the guard as the assembly is being attached to the handle and which releases the blade from the guard when the blade is attached to the blade carrier on the handle (column 6, lines 47-52), a safety catch comprising a peg (225; Figure 7) extending outwardly from one side of the guard, and a location means, the location means comprising a projection (221) on the guard which extend inwardly such that retraction of the guard causes the projection to ride over part of the blade and part

of the finger and then to snap behind part of the handle when the guard has been fully retracted, and providing and audible click sound when the projection snaps behind part of the handle (column 5, lines 1-22), and the handle having a rib (top edge of handle) and the guard containing a recess (aperture, 205), whereby the longitudinal rib extends into the longitudinal recess of the guard (Figures 4 and 5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-8 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Gringer (US 6,085,607)**.

Regarding claim 1, Kiehne discloses a safety scalpel blade assembly adapted for attachment to a handle of the type which has a blade carrier in the form of a finger (14), the assembly comprising a scalpel blade (10) which can be of conventional

manufacture, the scalpel blade having a slot (13) to allow the blade to be attached to the blade carrier on the handle, and a guard (11) which extends at least about the cutting edge of the blade (page 7, lines 17-19), the guard having attachment means (buttons and recesses) to lock the blade to the guard as the assembly is being attached to the handle and which releases the blade from the guard when the blade is attached to the blade carrier on the handle (page 9, lines 24-32 and page 10, lines 1-6).

Kiehne fails to disclose a removable tab on the guard having a portion which can be gripped by a person.

However, Gringer teaches a removable tab (extension) that can be gripped by a person (column 9, lines 19-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a removable tab to limit the movement of the blade while the tab is in place (column 3, lines 22-25).

Regarding claim 2, Kiehne discloses the device substantially as claimed above, but fails to disclose the removable tab having a head portion and a tail portion.

However, Gringer teaches the removable tab having a head portion and a tail portion (the two portions separated by notches in the tab), the head portion extending forwardly of the blade assembly, and the tail portion extending at least partially into a slot which is present in the guard (column 9, lines 23-35).

Regarding claim 3, Kiehne discloses the device substantially as claimed above, but fails to disclose the removable tab attached via at least one breakable portion.

However, Gringer teaches the removable tab having notches to allow for the tab to be broken away (column 9, lines 23-27)

Regarding claim 4, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to specifically disclose the breakable portion comprising a first portion and a second portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make more than one breakable portion since it has been held that mere duplication of essential working parts (breakable portions) of a device involves only routine skill in the art.

Regarding claim 5, Kiehne discloses the device substantially as claimed above, but fails to disclose the first breakable portion being close to the head portion of the removable tab, and breaking more easily than the second breakable portion.

However, Gringer teaches a first breakable portion closer to the head of the tab (Figure 50; column 9, lines 23-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first breakable portion closer to the head portion of the removable tab since it would be easier to remove the tab in that configuration (column 9, lines 25-27)

Regarding claim 6, Kiehne discloses the device substantially as claimed above, but fails to disclose an anti-lift means.

However, Gringer teaches a support structure designed to limit the ability of the blade carrier to move within the housing (guard) (column 6, lines 39-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an anti-lift device to limit unwanted movement and to give support to the blade and guard (column 6, lines 42-45).

Regarding claims 7 and 8, Kiehne discloses the device substantially as claimed above, but fails to disclose an engagement means on the handle which engages the guard.

However, Gringer teaches engagement means comprising an elongated rib in the handle and a groove in the guard so the guard can slide, but is not allowed to be lifted by the engagement of the rib or rail in the groove (column 6, lines 39-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an engagement means involving a rib and a groove since such a mechanism would give support to the blade and guard (column 6, lines 42-45).

Regarding claim 12, Kiehne discloses a safety scalpel assembly comprising a scalpel blade attached to a handle of the type which has a blade carrier in the form of a finger, the assembly comprising a scalpel blade having a slot to allow the blade to be attached to the blade carrier on the handle, and a guard which extends at least about the cutting edge of the blade, the guard having attachment means to lock the blade to the guard as the assembly is being attached to the handle and which releases the blade from the guard when the blade is attached to the blade carrier on the handle, but fails to disclose an anti-lift means.

However, Gringer teaches an anti-lift means to reduce the blade guard from lifting relative to the handle, the anti-lift means comprising an elongate recess in the blade guard which is adapted to engage a rib on the handle (column 6, lines 39-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an engagement means involving a rib and a groove since such a mechanism would give support to the blade and guard (column 6, lines 42-45).

6. **Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kiehne (WO 01/05312)** in view of **Gringer (US 6,085,607)** and further in view of **Abidin et al (EP 0 55 196 A1)**.

Regarding claim 9, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose safety catch to prevent excessive retraction.

However, Abidin et al. teaches a safety catch (end stops) comprising a projection to prevent excessive movement of the blade (column 5, lines 51-58)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a safety catch to prevent movement beyond a certain point (column 5, lines 51-52).

Regarding claim 10, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose a location means to positively locate the guard in the extended position and the retracted position.

However, Abidin et al. teaches an auditory location means that positively locates that the guard has been moved (column 2, lines 56-58; column 3, lines 1-4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a location means to signal to the user that the blade guard has been moved to a new position (column 2, lines 56-58).

Regarding claim 11, Kiehne in view of Gringer discloses the device substantially as claimed above, but fails to disclose at least one projection which engages at least one recess when the guard is in an extended or retracted position.

However, Abidin et al. teaches a projection (detent member) which engages at least one recess (detent pocket) when the guard is in an extended or retracted position (column 6, lines 3-8 and lines 40-52)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a projection that can hold the guard in the correct position during an operating (retracted) procedure, and a during a transfer (extended) of the device (column 6, lines 40-52).

Response to Arguments

7. Applicant's arguments filed 6/10/2008 have been fully considered but they are not persuasive.

Regarding claim 1, applicant's amendment to further define the tab as "being adapted to prevent at least the cutting edge of the blade from becoming exposed" is not sufficient to differentiate the claimed from prior art. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. It is interpreted that the tab of the combination of

Kiehne and Gringer is capable of performing the function of preventing the cutting edge of the blade from becoming exposed.

Regarding claim 12, applicant's claim that Gringer does not disclose an "anti-lift" means is not persuasive. The blade carriers and support platforms act as an anti-lift means to guide the blade guard on the handle without allowing the guard to lift relative to the handle. The carrier means are an elongate recess and rib combination that can act as an anti-lift means. While Gringer does not specifically cite "anti-lift" as one of the functions of the carrier means, the structural limitations disclosed are capable of performing the function claimed by the applicant.

8. Applicant's arguments with respect to claims 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE A. SZPIRA whose telephone number is (571) 270-3866. The examiner can normally be reached on Monday-Thursday 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Julie A Szpira/
Examiner, Art Unit 3731
/Todd E Manahan/
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